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APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,249	1	10/17/2001	Michele Fiscella	PT054P1	4118
22195	7590	09/22/2003			
		SCIENCES INC	EXAMINER		
) KEY WEST AVENUE CKVILLE, MD 20850			SPIEGLER, ALEXANDER H	
				ART UNIT	PAPER NUMBER
				1637	

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
Office Action Summers	09/978,249	FISCELLA ET AL.					
Office Action Summary	Examiner	Art Unit					
	Alexander H. Spiegler	1637					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period w Failure to reply within the set or extended period for reply will, by statute, - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). Status	36(a). In no event, however, may a reply within the statutory minimum of thirty (30 vill apply and will expire SIX (6) MONTHS cause the application to become ABANI	be timely filed 3) days will be considered timely. 5 from the mailing date of this communication. DONED (35 U.S.C. § 133).					
1)⊠ Responsive to communication(s) filed on <u>21 D</u>	December 2002 .						
2a) This action is FINAL . 2b)⊠ Thi	is action is non-final.						
3) Since this application is in condition for allowa closed in accordance with the practice under <i>B</i> Disposition of Claims							
4)⊠ Claim(s) <u>1-22</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)☐ Claim(s) is/are rejected.							
7) ☐ Claim(s) is/are objected to.							
8) Claim(s) 1-22 are subject to restriction and/or e	election requirement.						
Application Papers							
9)☐ The specification is objected to by the Examiner.							
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.							
If approved, corrected drawings are required in reply to this Office action.							
12) The oath or declaration is objected to by the Examiner.							
Priority under 35 U.S.C. §§ 119 and 120							
13) Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 11	19(a)-(d) or (f).					
a) ☐ All b) ☐ Some * c) ☐ None of:							
1. Certified copies of the priority documents have been received.							
2. Certified copies of the priority documents	• •						
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.							
14) Acknowledgment is made of a claim for domestic	priority under 35 U.S.C. § 1	19(e) (to a provisional application).					
a) ☐ The translation of the foreign language prov 15)☑ Acknowledgment is made of a claim for domestic							
Attachment(s)							
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Inform	mary (PTO-413) Paper No(s) mal Patent Application (PTO-152)					

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DETAILED ACTION

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Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 14, 15 and 22, drawn to nucleic acids, vectors, host cells and methods of making a polypeptide, classified in class 536, subclass 23.1 and class 435, subclasses 69.1, 320.1 and 325, for example.
 - II. Claims 11-12 and 16, drawn to polypeptides, classified in class 530, subclass 350, for example.
 - III. Claim 13, drawn to an antibody, classified in class 530, subclass 387.1, for example.
 - IV. Claim 17, drawn to a method of preventing, treating or ameliorating a medical condition by administering a polynucleotide, classified in class 514, subclass 44, for example.
 - V. Claim 18, drawn to a method of diagnosing a pathological condition by determining the presence or absence of a mutation in a polynucleotide, classified in class 536, subclass 24.3, for example.
 - VI. Claim 19, drawn to drawn to a method of diagnosing a pathological condition by determining the presence or amount of expression of a polypeptide, classified in class 435, subclass 7.1, for example.
 - VII. Claim 20, drawn to a method of identifying a binding partner, classified in class 436, subclass 501, for example.

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- VIII. Claim 21, drawn to a method of screening for molecules, which modify activities of a polypeptide, classified in class 435, subclass 4, for example.
- IX. Claim 22, drawn to a method of preventing, treating or ameliorating a medical condition by administering a polypeptide, classified in class 514, subclass 2, for example.
- 2. The claims of Group I-IX are drawn to a multitude of nucleic acids (SEQ ID NO: X), polypeptides (SEQ ID NO: Y), antibodies thereto and methods which use these compounds. Each of the different nucleic acids, polypeptides, antibodies and methods of use are independent and distinct because no common structural or functional properties are shared. Accordingly, these claims are subject to restriction under 35 U.S.C. § 121.

Upon election of one of Groups I-IX, Applicant is additionally required to elect a **single** nucleic acid, polypeptide, or antibody. This requirement is not to be construed as a requirement for an election of species, since each of the compounds is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

- 3. The inventions are distinct, each from the other because of the following reasons:
- A) The inventions of Groups I, II and III are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of Group I is composed of nucleotides linked in phospodiester bonds and arranged in space as a double helix. The polypeptide of Group II is composed of amino acids linked in peptide bonds and arranged spatially in a number of different tertiary structures including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The antibody of Group III is composed of

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amino acids linked in peptide bonds and arranged spatially in a very specific tertiary structure that allows that antibody to specifically bind to particular regions, i.e., epitopes, of the encoded polypeptide. Further, antibodies are glycosylated and their tertiary structure is unique, where four subunits (2 light chains and 2 heavy chains) associated via disulfide bonds into a Y-shaped symmetric dimer. Furthermore, the products of Groups I, II and III can be used in materially different processes, for example, the DNA of Group I can be used in hybridization assays, the antibody of Group III can be used in immunoassay, the polypeptide of Group II can be used to make fusion protein with an enzymatic function. Consequently, the reagents, reaction conditions, and reaction parameters required to make or use each invention are different.

Therefore, the inventions of Groups I, II and III are patentably distinct from each other. (See MPEP § 806.04, MPEP § 808.01, unrelated inventions)

- B) Inventions I and (IV-V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group I could be used in an entirely different method, such as in an amplification reaction or on an array, rather than in the methods of Groups (IV-V).
- C) Inventions I and (VI-IX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the DNA Group I is not required for the methods of Groups (VI-IX).

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D) Inventions II and (IV-V) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the polypeptide of Group II is not required for the methods of Groups (IV-V).

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- E) Inventions II and (VI-IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group II could be used in an entirely different manner, such as in a method of making antibodies rather than in the methods of Groups (VI-IX).
- F) Inventions III and (IV-IX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not required one for the other in that the antibody of Group III is not required for the methods of Groups (IV-IX).
- G) Inventions IV-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods, which have different method steps, starting materials and goals.

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4. Because these inventions are distinct for the reasons given above and have acquired a different status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-IX require different searches that are not coextensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

- 5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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Correspondence

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Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-

0806. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner are unsuccessful, the primary examiner in charge of the

prosecution of this case, Carla Myers, can be reached at (703) 308-2199. If attempts to reach

Carla Myers are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703)

308-1119. The fax number for the organization where this application or proceeding is assigned

is (703) 872-9306. Applicant is also invited to contact the TC 1600 Customer Service Hotline at

(703) 308-0198.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-0196.

Alexander H. Spiegler

September 15, 2003

CARLA J. MYERS